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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/754,929  | 01/04/2001  | David B. Swentor     | 24482/002           | 3849             |
| 7590  | 09/14/2005  |                      | EXAMINER            |                  |
| John B. Hardaway, III<br>HARDAWAY/MANN IP GROUP<br>NEXSEN PRUET JACOBS & POLLARD, LLC<br>P.O. Box 10107, Fed. Sta.<br>Greenville, SC 29603-0107 |             |                      | MILEF, ELDA G       |                  |
|   |             | ART UNIT             | PAPER NUMBER        | 3628             |
| DATE MAILED: 09/14/2005   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                   |
|------------------------------|------------------------|-------------------|
| <b>Office Action Summary</b> | Application No.        | Applicant(s)      |
|                              | 09/754,929             | SWENTOR, DAVID B. |
|                              | Examiner<br>Elda Milef | Art Unit<br>3628  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 February 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1 and 12 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,12 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentino (US Patent No. 4,648,037 in

view of D'Antoni (D'Antoni et al., PG Pub. No.: US 2003/0139996).

**Re claim 1:** Valentino discloses:

a. data repository for storing integrated employer and employee meta-accounts ("The benefit and financial communication service provides a powerful tool for corporations to use in providing benefit and financial information directly to employees based on the plans offered by their corporate employers. The invention has its roots in a data processing system environment; however the invention significantly enhances the manner of presentation.")-see col. 2, lines 28-32 and ("As shown in FIG. 4, the system configuration comprises a plurality of components including... the database in memory 26, the computer 24 and the software therefor, and the communication facilities.")-see col. 4, lines 41-45;

b. an integration system that enables third party applications to access said data repository ("Players in the Benefit and Financial Communication Service... 1. The user--The employee or consumer who uses the benefit and financial communication service for information retrieval, "what if" games (interactive capability), and generating transactions. 2. The

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communications network provider (e.g., common carrier). 3. The system operator--The corporation which operates the system, i.e., manages the service, controls the access, and monitors usage. 4. The information service provider (e.g., the sponsoring corporation whose information is presented by the system)--see col. 4, lines 25-37;

c. a presentation system to provide interface services, which is accessible to a customer service representative ("The system operator--The corporation which operates the system, i.e., manages the service, controls the access, and monitors usage.")-see col. 4, lines 33-35, and ("The system operator brings up the system on a daily basis by dialing the appropriate extension to connect the system with the computer. Upon receiving the appropriate dial tone from the telephone, the system operator will press the connection key on the terminal keyboard which will bring up certain system prompts. A valid identification sequence will result in the display of the introductory screen that is presented to the employee.")-see col. 11, lines 63-65.

d. a business logic system that provides application services to said presentation system, wherein said business logic systems comprise:

1. accounting services;
2. benefits services;
3. insurance services;
4. banking services;
5. information services;

("The benefit and financial communication service of the present invention utilizes an easy-to-use unattended computer terminal for the direct use of employees who are generally untrained with respect to the operation of a computer terminal. The invention is based upon a synthesis of technology and various business expertise (as found in areas concerned with employee benefit planning, financial planning, retirement planning, etc.) to create a unique communication and education medium. The invention includes a terminal supported by a sophisticated computer-based process which delivers various services."-see col. 1, lines 57-67 and ("The system of the invention enables the employee to access information concerning their up-to-date savings plans and the values thereof, withdrawal information, explanations of provisions, employee benefit information (e.g.,

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group life insurance, disability coverage, vested retirement, etc.), explanations of savings plan and benefit options, and benefit news bulletins... forecasts of accumulated values of voluntary salary savings and other deferred compensation programs, forecasts of dollar benefit of new savings plans, IRA's, 401K's, etc., the results of different combinations of benefit coverages (as would be required under a flexible benefit plan arrangement) and the implications of each variation, as well as the results of "what if" financial games.")-see col. 2, lines 4-21. The Examiner is interpreting accounting services as the classification, analysis and interpretation of the financial data of an employee and is therefore shown above.

Valentino discloses:

wherein said business logic system is directly accessible by said customer service representative to manage the services of said business logic system ("The system operator--The corporation which operates the system, i.e., manages the service, controls the access, and monitors usage.")-see col. 4, lines 33-34.

Valentino does not disclose that the business logic system comprise merchandising services. D'Antoni teach ("In this specific embodiment, to provide further added value for

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Customers, the Facilitating Entity may negotiate with an employee services provided to provide employee services, e.g., access to employee health insurance, discounted entertainment or travel, to Employees of Customers of Business Partners or Employees of the Business Partners themselves. This has the benefit of provided the Customer with access to employee services that might otherwise be unavailable or costly to obtain...The employee services provider obtains advertising and marketing assistance directed to attractive but hard to reach small and medium sized Customers.")-see para. 19. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Valentino to include offering employee discounts on goods and services as part of the benefits package (merchandising services) as was done by D'Antoni in order to for companies to attract talented employees and offer an attractive benefits package.

**Re claim 12:** Valentino discloses:

a. data repository for storing integrated employer and employee meta-accounts -see col. 2, lines 28-32 and col. 4, lines 41-45;

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b. an integration system that enables third party applications to access said data repository -see col. 4, lines 25-37.

c. a presentation system to provide interface services, wherein said presentation system enables a user to access and manage the services of said business logic system, ("The user--The employee or consumer who uses the benefit and financial communication service for information retrieval, "what if" games (interactive capability), and generating transactions")-see col. 4, lines 27-30.

Valentino discloses:

using an access device selected from the group of:

1. a kiosk;
2. a telephone using touch-tones and/or voice;
3. a personal digital assistant;
4. a personal computer; and

("The direct link between the service and the employee is the terminal or kiosk 20, shown in FIG. 1.")-see col. 3, lines 31-33

d. a business logic system that provides application services to said presentation system, wherein said business logic systems comprise:

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1. accounting services; 2. benefits services;  
3. insurance services; 4. banking services; 6. information  
services

("The benefit and financial communication service of the present invention utilizes an easy-to-use unattended computer terminal for the direct use of employees who are generally untrained with respect to the operation of a computer terminal. The invention is based upon a synthesis of technology and various business expertise (as found in areas concerned with employee benefit planning, financial planning, retirement planning, etc.) to create a unique communication and education medium. The invention includes a terminal supported by a sophisticated computer-based process which delivers various services."-see col. 1, lines 57-67 and ("The system of the invention enables the employee to access information concerning their up-to-date savings plans and the values thereof, withdrawal information, explanations of provisions, employee benefit information (e.g., group life insurance, disability coverage, vested retirement, etc.), explanations of savings plan and benefit options, and benefit news bulletins... forecasts of accumulated values of voluntary salary savings and other deferred compensation programs, forecasts of dollar benefit of new savings plans, IRA's, 401K's, etc., the results of different combinations of

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benefit coverages (as would be required under a flexible benefit plan arrangement) and the implications of each variation, as well as the results of "what if" financial games.")-see col. 2, lines 4-21. The Examiner is interpreting accounting services as the classification, analysis and interpretation of the financial data of an employee and is therefore shown above.

Valentino discloses:

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Valentino does not disclose that the business logic system comprise merchandising services. D'Antoni teach ("In this specific embodiment, to provide further added value for Customers, the Facilitating Entity may negotiate with an employee services provided to provide employee services, e.g., access to employee health insurance, discounted entertainment or travel, to Employees of Customers of Business Partners or Employees of the Business Partners themselves. This has the benefit of provided the Customer with access to employee services that might otherwise be unavailable or costly to

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obtain...The employee services provider obtains advertising and marketing assistance directed to attractive but hard to reach small and medium sized Customers.")-see para. 19. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Valentino to include offering employee discounts on goods and services as part of the benefits package (merchandising services) as was done by D'Antoni in order to for companies to attract talented employees and offer an attractive benefits package.

***Conclusion***

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will

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expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Harris, Elana. *Doing The Right Thing*. Sales and Marketing Management. New York: Dec 2000. Vol. 152, Iss. 12; pg. 19, 1 pgs. Cited for its reference to employee benefit packages that offer discounts on everything from discounted travel to groceries.

***Response to Arguments***

4. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elda Milef whose telephone number is (571)272-8124. The examiner can normally be reached on Monday - Friday 9:15 am to 5:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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